

REMARKS

The Examiner has objected to the disclosure due to informalities. In response, the specification has been amended hereinabove accordingly, in order to overcome such objection.

The Examiner has also objected to Claim 5 in view of formalities. Applicant asserts that such objection is moot in view of the clarifying amendment made hereinabove.

The Examiner has rejected Claims 9 and 12 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A clarifying amendment has been made to such claims in order to avoid such rejection.

The Examiner has rejected Claims 1-8 under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,398,196 to Chambers in view of US Patent 5,649,095 to Cozza in view of applicant's admitted prior art (AAPA). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove.

Specifically, the Examiner relies on the following excerpt from Chambers to meet applicant's claimed "detecting a request for closure of an opened computer file" and "determining in response to a closure request if the opened computer file has been modified since being opened" (or similar, but not identical, language) in each of the independent claims.

"As shown in FIG. 9, when the interrupt handler routine is entered at block 900, the first action is to open the guinea pig file, at block 910, after which the guinea pig file is closed at block 920. Next, at block 930 the interrupt handler testing routine examines the guinea pig file to determine if its content has been changed. Such would be the result of a virus having contaminated the interrupt handlers for opening or closing files." (col. 10, lines 7-14)

Such excerpt, however, discloses the closure of a file in a first block (920), after which, in a subsequent block (930), the file is scanned to determine if its contents have changed. In stark contrast, applicant teaches and claims "determining in response to a closure request if the opened computer file has been modified since being opened" (emphasis added). Thus, it is clear that Chambers teaches the scanning of a file *in response* to the actual closure of the file, and not in response to a file closure request, as claimed by applicant.

This distinction is paramount, since Chambers closes (and thus writes) the file before it is checked. This is inherently dangerous to a computer system, since a virus would be found only after the file has been closed and written, and damage done. Thus, Chambers *teaches away* from applicant's claimed invention, and *fails to even recognize the problem* solved by applicant. Only applicant teaches and claims scanning a file *in response to a closure request*, for this purpose.

In the interest of expediting the prosecution of the present application, applicant has further amended the claims to emphasize this distinction. Specifically, now claimed in each of the independent claims is the operation of "determining in response to and after a closure request, but before file closure, if the opened computer file has been modified since being opened" (or similar, but not identical language – emphasis added). A notice of allowance or a specific prior art showing of such claim limitations in combination with the remaining limitations is respectfully requested.

The Examiner continues by relying on applicant's admitted prior art (AAPA) to make a prior art showing of applicant's claimed "scanning said opened file for viruses before closure" and "closing said file after scanning for viruses if found virus free."

Applicant notes that the remaining limitations of applicant's claims include the following: 1) "only if said opened file has been modified" and "closing said file if unmodified." The Examiner concludes by relying on the following excerpt from Cozza to meet these remaining limitations.

"For example, if the size of a file's resource fork is stored as part of the cache, then if a file's resource fork size remains the same as determined by comparing the file's precise resource fork size with that stored in the cache, then it is not necessary to scan for those viruses which change a file's resource fork size. For the same reasons, when certain characteristics of a file or volume remain the same, then it is not necessary to scan for those viruses which change those certain file or volume characteristics. It is thus clear that proper selection of the file and volume characteristics to be stored in the cache will guarantee a great scanning speed increase by eliminating unnecessary, repeat scanning in return for a very modest cost in terms of disk or other non-volatile storage medium." (col. 4, lines 4-17)

Such excerpt, however, makes no mention of the remaining claim limitation "closing said file if unmodified." Applicant emphasizes that the reason for this deficiency is due to the fact that the Examiner has simply broken down applicant's claim language into components (i.e. phrases, adjectives, nouns, etc.), and has then attempted to make a prior art showing of such components in a vacuum. Thus, the Examiner's rejection may be considered analogous to gleaning phrases, adjectives, nouns, etc. from applicant's claims, and then using prior art references collectively as a dictionary to make a prior art showing of such phrases, adjectives, nouns, etc.

Applicant asserts that a claim is anticipated only if each and every element as set forth in the claim is found, and the elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). In view of the manner in which the Examiner has simply mapped phrases, adjectives, nouns, etc. of applicant's claims to the prior art, applicant asserts that the elements of the Examiner's proposed combination are simply not arranged as required by applicant's claims.

More importantly, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991). Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has simply not been met, as set forth hereinabove.

A notice of allowance or a specific prior art showing of each of the claim limitations noted above, arranged as required by the claims, is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees

due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. NAI1P194/99.115.01).

Respectfully submitted,

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